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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,694	05/04/2000	Noriyuki Nakaoka	Q58984	3536

7590

11/19/2002

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2100 Pennsylvania Avenue NW
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EXAMINER

BERNATZ, KEVIN M

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 11/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/530,694

Applicant(s)

NAKAOKA ET AL.

Examiner

Kevin M Bernatz

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 11.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Amendments to claims 1, 6, and 8 - 10, filed on September 5, 2002, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Examiner's Comments

3. With regard to the transitional phrase "consisting essentially of", the examiner reminds applicants that the transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original). See MPEP § 2111.03. Furthermore, the burden is **upon applicant(s)** to show that the other ingredients materially affect the basic and novel characteristics of the invention. *In re Janakirama-Rao*, 317 F.2d 951, 137 USPQ 893 (CCPA 1963).

In the telephone conversation on November 15, 2002, applicants commented on the possibility of amending the claims to recite consisting essentially of Fe and the elements recited on page 7, third paragraph. The examiner wishes to clarify that applicants would still have the burden of showing that elements besides those listed would materially affect the basic and novel characteristics of the invention, where the

“basic and novel characteristic” is the broad ‘improvement’ or ‘benefit’ achieved (see examples cited in MPEP section 2111.03 which defines an example of the basic and novel characteristic simply as “improved oxidation resistance”).

In the instant case, the examiner deems that the basic and novel characteristic of the invention is superior magnetic characteristics (page 4 and Tables 1 and 2) and there is currently no evidence of record that additional elements such as Ni would prevent the invention from still achieving “superior magnetic characteristics”.

Claim Rejections - 35 USC § 102

4. Claims 1 and 6 are rejected under 35 U.S.C. 102(a) as being anticipated by Nakanishi et al. ('361 A) for the reasons of record as set forth in Paragraph No. 6 of the Office Action mailed on June 5, 2002 (Paper No. 8).

Regarding the transitional phrase “consisting essentially of”, applicants are reminded that they have the burden of showing that the additional elements (in this case Ni) would materially affect the basic and novel characteristic of the invention (see Paragraph 3, above).

5. Claims 1, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Whetstone ('379) for the reasons of record as set forth in Paragraph No. 7 of the Office Action mailed on June 5, 2002 (Paper No. 8).

Claim Rejections - 35 USC § 103

6. Claims 2 – 4, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whetstone ('379) in view of Manning et al. ('460) for the reasons of record as set forth in Paragraph No. 10 of the Office Action mailed on June 5, 2002 (Paper No. 8).

Response to Arguments

7. **The rejection of claims 1 and 6 under 35 U.S.C § 102(a) – Nakanishi et al.**

Applicant(s) argue(s) that due to the thickness of the layers in Nakanishi et al., none of the layers could be divided by heat treatment. The examiner respectfully disagrees.

Applicants are reminded that attorney arguments are not evidence and applicants are invited to present evidence that the layers of Nakanishi et al. would not divide by any amount upon the heat treatment disclosed in the Nakanishi et al. invention. In addition, the examiner notes that claim 6 merely requires that the sheet is “provided with a shape of a sheet partially divided”, which does not require heat treatment to achieve the claimed shape (in addition, the examiner notes that an amendment to add such a limitation to claim 6 would be a product-by-process limitation).

**8. The rejection of claims 1 - 10 under 35 U.S.C § 102(b) or 103(a) –
Whetstone, either alone or with Manning et al. ('460)**

Applicant(s) argue(s) that the layers of Whetstone must be continuous. The examiner respectfully disagrees.

As above, the examiner respectfully notes that attorney arguments are not evidence and applicants are invited to present evidence that the layers of Whetstone would inherently be continuous and not in the form of a sheet partially divided, even though Whetstone disclose heat treating the product.

Applicants further argue that the purpose of the heat treatment used in Whetstone is patentably distinct from the heat treatment applied in the present invention. The examiner respectfully disagrees.

The examiner notes that the reason for doing a specific processing step or arriving at a specific product is not a patentably distinct limitation unless it can be shown that such a thought process or motivation produces a materially different product (i.e. if the heat treatment was performed in a different manner, then the difference in the **method** would result in a patentably distinct invention **if** no motivation or anticipation could be found in the prior art to use the claimed method). In the instant case, the claimed method merely requires heating, which is taught by Whetstone.

The examiner notes that the specification is not the measure of the invention. Therefor, limitations contained therein (such as temperature ranges or holding times) cannot be read into the claims for the purpose of avoiding prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968). In addition, the examiner has

provided motivation for controlling the holding time and temperature of heating to within applicants' claimed limitations (rejection of claim 2).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (703) 308-1737. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



KMB
November 15, 2002



Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700